

REMARKS

By the present amendment, Applicant has amended Claims 1, 5, 6, 9, 12 and 13. Claims 7, 8, 10 and 17 have been cancelled. Claims 1-6, 9 and 11-16 remain pending in the present application. Claims 1, 12 and 13 are independent claims.

In the recent Office Action the Examiner required a more descriptive title. The title of the present application has been changed in accordance with the Examiner's suggestion. The Examiner also objected to Claim 1 as containing a typographical error. By the present amendment, the informality has been corrected, thereby obviating the objection to the claim. Claim 12 has been amended to correct a typographical error as well.

In the recent Office Action the Examiner rejected Claims 1 and 3 under 35 U.S.C. § 102(b) as being anticipated by Bauer et al. (US 5,582,430). Claims 2, 4-9, 11, 13, 14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bauer et al. (US 5,582,430), taken alone. Claims 10, 15 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bauer et al. (US 5,582,430) in view of Finnson (US 5,700,022). And, Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson (US 3,934,900) in view of Bauer et al. (US 5,582,430).

Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

The Examiner has rejected Claims 1 and 3 under 35 U.S.C. § 102(b) as being anticipated by Bauer et al. (US 5,582,430). However, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP § 2131. The patent to Bauer et al. (US 3,934,900) discloses a spray protection device for reducing the spray occurring behind a traveling vehicle and produced by the wheels running on wet roads. The device is comprised of a first flat side facing the vehicle wheel and a second side facing away from the wheel. Both the first side and the second side can be formed by a variety of disclosed materials. The first side, or inlet layer, is disclosed as being formed from a textile material selected from the group consisting of woven fabrics, weft-knitted fabrics, knitted fabrics, and fleeces (Bauer et al., col. 9, lines 2-5). The first side may be attached to the second side, or spacer layer, by any of a number of means, including gluing (Bauer et al., col. 4, lines 25-32). With Applicant's amended claim 1 in mind, it can be seen that Bauer et al. does not show a bead of adhesive sealant disposed around the edge of the liner (inlet layer) for sealing the liner to the fender. Since Bauer et al. does not show each

and every feature of Applicant's amended Claim 1, the rejection of Claims 1, and dependent Claim 3 under § 102(b) is not proper and should be withdrawn.

The Examiner has rejected Claims 2, 4-9, 11, 13, 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Bauer et al. (US 5,582,430), taken alone. And, Claims 10, 15 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bauer et al. (US 5,582,430) in view of Finnson (US 5,700,022). However, since limitations found in dependent claims 10 and 17 have now been added to independent claims 1 and 13, respectively, the rejection of Bauer et al. in combination with Finnson will be reviewed.

As noted above, Bauer et al. lacks 1) a bead of adhesive sealant disposed around the edge of the liner, or inlet layer, for sealing the liner to a fender. In addition, Bauer et al. does not show 2) a liner, or inlet layer, that is made of open-cell, polymeric, plastic, foam material. Nor, does Bauer et al. disclose 3) a liner attached to a wheel cover/fender by an adhesive, 4) the thickness of the liner being approximately one fourth of an inch thick, 5) the liner extending to within ¼ inch of a lower edge of a fender, or 6) the method step of applying a bead of waterproof adhesive sealant around the liner and backing material to form a seal between the liner and fender surface.

Recognizing these deficiencies in Bauer et al. the Examiner turns to the teachings of Finnson. The patent to Finnson shows a collapsible shield made of an elongated sheet 12,

and a pair of elongated panels 14. The Examiner points to a facility 16, which is for attaching each elongated edge of the elongated sheet 12 to elongated panels 14. Finnson discloses the attaching facility 16 as "a heat seal 24 between each longitudinal edge of the elongated sheet 12 and the longitudinal center of each elongated panel 14" (Finnson, col.3, line 66 through col.4, line 1). The Examiner believes that it would have been obvious to one with ordinary skill in the art to modify the spray protection device of Bauer et al. by manufacturing the liner at approximately one fourth of an inch thick, to form the liner of open-cell material, to connect the liner backing to the wheel cover/fender by adhesive bonding, and to place the liner on the wheel cover/fender such that it is ¼ inch from a lower edge thereof. The Examiner further believes that it would have been obvious, in view of what is shown in Finnson, to provide a bead of adhesive sealant around the edge of the liner of Bauer et al. Applicant does not agree.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

There is nothing in the teachings of the relied upon prior art references which would have suggested the desirability, and thus the obviousness of the Examiner's modifications of the spray protection device of Bauer et al. In this regard, it is pointed out that the device of Bauer et al. is not intended for the same purpose as Applicant's invention. Bauer et al. is concerned with reducing and suppressing the spray from vehicle wheels, wherein the device blocks, holds and allows the spray to then run off the device. Note, Bauer et al. at column 3, line 27, which speaks of how the device is constructed to "guarantee absorption". This is unlike Applicant's present invention, which is concerned with, and solves the problem of mud build-up, by a mud-resistant construction.

Further, nowhere in Bauer et al., Finnson, or any of the cited prior art is the use of open-cell, plastic, foam disclosed as being used as a mud resistant liner. Bauer et al. forms his liner from textile materials, which clearly does not include open-cell, foam. Thus, it would not have been obvious to one of ordinary skill in the art to make the textile based liner of Bauer et al. from open-cell foam as the Examiner urges, since there is nothing in the prior art to suggest this modification.

The Examiner points to column 4, lines 27-29 as a teaching that it would have been obvious "to connect the liner/spray protection device to the wheel cover/fender using a layer of adhesive bonding" (Office action, p. 5, line 3-4). However, that particular passage in Bauer et al. refers solely to the makeup and construction of the spray protection device, and

not to the manner in which device is attached to the wheel cover/fender. Thus, it would not have been obvious to one of ordinary skill in the art to attach the liner of Bauer et al. to a wheel cover/fender by a layer of adhesive bonding as the Examiner urges, since there is nothing in the prior art to suggest this.

Finally, the “heat seal” 24 of Finnson is not a bead of adhesive sealant. And, it is not clear just how the Examiner proposes to modify the liner and wheel cover/fender of Bauer et al. with the teachings the “heat seal” of Finnson. There simply is no suggestion or incentive supplied in either of the two applied references to indicate that the modifications urged by the Examiner would have been obvious to one with ordinary skill in the art. As a result, and for the above noted reasons, the Examiner’s rejection of Claims 2, 4-6, 9, 11, 13, 14 and 16 under 35 U.S.C. § 103(a), claims 7, 8, 10 and 17 having been cancelled by the present amendment, is deemed improper and should be withdrawn.

The Examiner rejected Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Wilson (US 3,934,900) in view of Bauer et al. Wilson discloses a combined fender and splash-guard for a motorcycle. The fender, which includes an upper surface and a concave lower surface, and the splash-guard are integrally formed and injection molded as a one-piece structure. The splash-guard is formed at the front and/or rear tip of the fender. With Applicant’s Claim 12 in mind, it is noted that Wilson does not show 1) a mesh backing adhesively attached to the lower surface of the fender, and 2) an open-cell foam liner

adhesively attached to the mesh backing. The teachings of Bauer et al., and the lack thereof, have been discussed above. The Examiner believes that it would have been obvious to “add a liner/spray protection device to the fender of Wilson to reduce the spray occurring behind a traveling vehicle and produced by wheels running on wet roads” (Office action, p. 7, lines 4-6). The Examiner further determines that it would have been obvious “to connect the mesh backing using adhesive bonding, since Bauer et al. states at column 4, lines 27-29 that such a selection in connection process could depend on the materials used” (Office action, p.7, lines 7-11). Once again, Applicant is not in agreement.

In this regard, and as was discussed above, the column 4, line 27-29 recitation in Bauer et al. refers to the liner construction itself, and not to the manner in which the liner is attached to the wheel cover/fender. Thus, it would not have been obvious to modify the structure of Wilson, which shows no liner or backing of any kind attached to the lower surface, by adhesively attaching a mesh backing thereon, as the Examiner proposes. And, as was also discussed above, since neither Bauer et al. nor any of the prior art references discloses the use of an open-cell foam liner as a mud resistant liner, this too would not have been an obvious modification to one of ordinary skill in the art. Thus, the Examiner’s rejection of Claim 12 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

A conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by

knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on ' 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). In the present application, there is no teaching, suggestion or incentive in any of the applied references that would have led one of ordinary skill in the art to make the Examiner's proposed modifications to either the spray protection device of Bauer et al. or the fender and splash guard of Wilson. Indeed, many of the modifications are not shown in the teaching references (e.g. a foam liner, a bead of adhesive sealant, a layer of adhesive bonding the liner to the fender, the method step of applying a bead of waterproof adhesive sealant, etc.), and it is only by impermissible hindsight and reliance on Applicant's own disclosure that the Examiner would have been led to reconstruct the spray protection device of Bauer et al. or the fender and splash guard of Wilson so as to derive Applicant's claimed mud resistant liner combination from the applied teachings. It is therefore Applicant's conclusion that the combined teachings of Bauer et al., Finnson and Wilson fail to establish a *prima facie* case of obviousness.

Application No. :10/691,525
Art Unit:3618

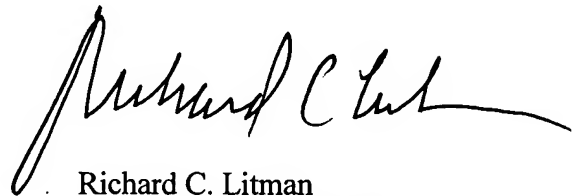
Attorney Docket No.23708.00
Confirmation No.7430

The references cited by the Examiner, but not used in the rejection of the claims, have also been carefully reviewed, however, Applicant finds nothing therein which would overcome or supply that which is lacking in the basic combination of the other applied prior art noted above.

The claims in this application have been revised to more particularly define Applicant's unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the above-noted reasons is respectfully requested.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard C. Litman", with a long horizontal flourish extending to the right.

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